

**REMARKS****Status of the claims**

Claims 1-60 are pending in the application. Claims 1-33 and 53-60 are withdrawn from consideration. Claims 34-52 stand rejected.

**Claim amendment**

Claim 34 has been amended to incorporate the limitations of claim 1. This is intended to overcome the 35 U.S.C. §112 rejection. Claim 1 has also been amended to be drawn to a method of ablating tissue [abstract].

**Priority**

The Examiner states that the disclosure of the prior-filed application, Application No. 10/670,618 and 60/413,351, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 47 and 48. As such, these limitations will only be given priority to the filing date of the current application. The Applicants respectfully disagree.

While prior-filed application, Application No. 10/670,618 and 60/413,351, do not specifically mention the use of magnetic fields and eddy currents per se, it does disclose that electromagnetic energy may induce alterations of the stratum corneum [paragraph 0006] and the use of multiple electrodes to measure the electrical properties of the treatment site (tissue) and provide feedback to the device [paragraph 0055]. Thus, the Applicants respectfully request that claims 47 and 48 be given the priority of the prior-filed application.

**The 35 U.S.C. §112 rejection**

Claims 34-52 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner states that claim 34 is dependent on claim 1 which is drawn to a nonelected species. For examination, the Examiner has taken under consideration claim 34 to include the structural limitations of nonelected claim 1.

The Applicants have amended claim 34 to remove references to claim 1. In view of this amendment, the Applicants request that the 35 U.S.C. §112 rejection be removed.

**The 35 U.S.C. §102 rejection**

Claims 34-46 and 49-52 are rejected under 35 U.S.C. §102(e) as being anticipated by Miller *et al.* (US 2003/0208235).

The Examiner states that *Miller et al.* disclose a method comprising the steps of contacting a tissue with an applicator actuated by a driving means- the application of an abrasive driven mechanically- which is performed in conjunction with the iontophoresis; dispensing a pharmaceutical while altering the tissue; monitoring electrical current between an active and return electrode; applying electrically conductive fluid interface between the electrode and the tissue; and controlling the device via a microprocessor in a controller.

The Applicants submit that *Miller et al.* disclose a device and method for iontophoretically transporting a compound through localized region of an individual's body tissue. More particularly the device comprises multiple iontophoretic electrodes, a current source and a monitoring means. *Miller et al.* also disclose means for monitoring and controlling electrical resistance at the site undergoing iontophoresis.

The Applicants have currently amended claim 34 to be directed towards a method of ablating tissues. The Applicants submit that *Miller et al.* do not anticipate the claimed invention because they are drawn towards distinct methods. *Miller et al.* is directed towards a method of iontophoresis. Thus, their device and method alter the skin's permeability thereby increasing the migration of a particular ion through the skin. The advantage of their method is that the skin need not be ablated or punctured via a needle.

By contrast, the claimed invention is now drawn to a method of ablating tissue which also increase the permeability of particular molecules across skin but results in physically altering stratum corneum. Therefore, the claimed invention is novel because it is drawn to a wholly different method than that disclosed in *Miller et al.*

Furthermore, *Miller et al.* only disclose monitoring and controlling electrical resistance to control the electrical parameters at the iontophoretic electrodes. By distinct contrast, the claimed invention (claims 42-46) are drawn to a method of tissue ablation wherein the electrical property of tissues are monitored in order to monitor the tissue alteration process.

In view of the claim amendment, the Applicants respectfully request that the rejection of claims 34-46 and 49-52 under 35 U.S.C. §102 be removed.

Claims 34-42 and 47-52 are rejected under 35 U.S.C. §102(e) as being anticipated by *Handy et al.* (US 2003/0032995).

The Examiner states that *Handy et al.* disclose a method comprising the steps of contacting a tissue with an applicator actuated by a driving means; dispensing a

pharmaceutical while altering the tissue; generating and monitoring eddy currents to control the device via microprocessor in a controller. The Applicants respectfully disagree.

The Applicants submit that *Handy et al.* disclose a method of treating a patient by administering a magnetic composition comprising at least one magnetic particle attached to a ligand specific to a predetermined target in the patient and applying an alternating magnetic field to the magnetic composition to inductively heat the composition. More particularly, the composition is administered via intraperitoneal injection, intravascular injection, intramuscular injection, subcutaneous injection, topical, inhalation, ingestion, rectal insertion, wash, lavage or rinse perisurgically, or extracorporeal administration into patient's bodily materials.

The Applicants respectfully submit that *Handy et al.* do not anticipate the claimed invention. As discussed *supra*, the Applicants have amended claim 34 to be drawn towards a method of ablating tissue in order to increase the permeability of skin. Thus, the currently amended claim 34 is drawn to wholly different method than *Handy et al.* Nowhere in *Handy et al.* is there any recitation of tissue ablation. In fact, the composition taught by *Handy et al.* is administered via traditional and well known methods such as intraperitoneal injection, intravascular injection, intramuscular injection, subcutaneous injection, topical, inhalation, ingestion, rectal insertion, wash, lavage or rinse perisurgically, or extracorporeal administration into patient's bodily materials. Thus, *Handy et al.* do not disclose nor have any need to increase the permeability of skin tissues in order to administer their composition. Because the claimed invention is drawn to a wholly different method than *Handy et al.*, the Applicants submit that there is no anticipation.

Furthermore, *Handy et al.* make no mention of monitoring currents or resistance to track and control the tissue ablation process as recited in claims 42-46

In view of the amendments to claim 34 and the arguments presented herein, the Applicants respectfully request that the rejection of claims 34-42 and 47-52 under 35 U.S.C. §103 be removed.

#### Double Patenting

Claims 34-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 12/321,885 and claims 1 and 34-37 of copending Application No. 10/670,618.

The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because each disclose methods of treating tissue

comprising the steps of contacting the tissue with an actuated applicator and monitoring an electrical property of the tissue during treatment.

Applicants include herewith a Terminal Disclaimer under 37 C.F.R. §1.321 Accordingly, Applicants respectfully request that the provisional double patenting rejection of claims 34-46 be withdrawn.

This is intended to be a complete response to the Office Action mailed July 14, 2009. A Petition for Extension of Time and PTO Form-2038 are also enclosed herewith. In absence of this form, please debit the petition fee or any other fees due from Deposit Account 07-1185. Applicants submit that the pending claims are in condition for allowance. If any issues remain outstanding, please telephone the undersigned attorney of record for immediate resolution.

Respectfully submitted,

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